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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/591,903

09/07/2006

Yoshihiko Nagata

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07/30/2009

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

07/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/591,903 | Applicant(s) NAGATA ET AL. | |
| | Examiner James Mackey | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/7/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Specification

The disclosure is objected to because of the following informalities: on pages 12-13 of the specification, paragraph [0028] repeats the recitations for drawing Figures 1 and 3-11 from the brief description of the drawings on pages 10-11.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the central connection member “comprising a plurality of members” (disclosed at page 20 of the specification, paragraph [0038]), as claimed in claim 17, must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The original disclosure does not adequately describe, nor enable, a mold-supporting apparatus wherein the rear surface portion includes a mounting portion secured to a frame, wherein “the mounting portion is provided at a location such that deformation of the rear surface portion in the vertical direction is suppressed”, as is claimed in claim 20. While the original disclosure recites those words (paragraph [0020] on page 8), and also describes mounting portions 18 and attachment leg members 18a (paragraphs [0033]-[0034] on pages 16-17), the original disclosure does not adequately describe the location of the mounting portion in combination with the function of suppression of deformation of the rear surface portion in the vertical direction, nor does the original disclosure enable one of ordinary skill in the art to configure the location of the mounting portion to accomplish the function of suppression of deformation of the rear surface in the vertical direction, as claimed in claim 20.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, “a central portion” on line 2 and “a central portion” on line 3 are indefinite as to exactly how they relate to each “central region” as recited in independent claim 13 at line 8.

In claim 17, “a central region” on line 2 and “a central region” on line 3 should each be changed to --said central region-- to clearly refer to the previously-recited central regions as recited in independent claim 13 at line 8.

In claim 19, line 2, “the reaction force receiving portion” is indefinite as to which of the plural receiving portions recited in independent claim 13 is intended.

In claim 20, line 4, “at a location” is unclear and indefinite as to exactly which element this “location” is provided on; and lines 4-5, “such that deformation ... is suppressed” is of indefinite scope, since it is not clear what the suppression is relative to (in other words, suppressed in relation to what?).

Claim 22 provides for the use of a mold-supporting apparatus, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

In claim 23, line 19, “high pressure” is a relative term of indefinite scope, since the metes and bounds of what is considered “high” cannot be ascertained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-18 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1,287,962.

EP '962 teaches a mold support platen comprising a mold mounting portion having a mold mounting surface 1 to which a mold 8 is mounted; and a rear surface portion 2 having reaction-force-receiving portions 6 at corners thereof; wherein a central region of the mold mounting portion and a central region of the rear surface portion being connected together by means of a central connection member shown as being a single member 9 (see Fig. 4) as well as a plurality of members 4 (see Fig. 2), and the central connection member having a symmetric outer peripheral shape; wherein an outer peripheral portion of the mold mounting portion and an outer peripheral portion of the rear surface portion are connected together by means of an outer peripheral portion connection member 3; and wherein an annular cavity portion is formed between the mold mounting portion and the rear surface portion to surround the central connection

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member, and a through-hole 7 communicating with the annular cavity portion is formed in a surface adjacent to the mold mounting surface (as clearly shown in Figs. 1 and 4). EP '962 also inherently teaches a molding method for injection molding molten resin into the mold cavity of a mold mounted to such a mold support platen, as claimed.

Claims 13, 15, 16, 18, 19 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Becker et al. (U.S. Patent 6,776,605).

Becker et al. teach a mold support platen 1 comprising a mold mounting portion having a mold mounting surface 2b to which a mold is mounted; and a rear surface portion having reaction-force-receiving portions 12 at corners thereof; wherein a central region of the mold mounting portion and a central region of the rear surface portion being connected together by means of a central connection member 5 shown as being a single member having a symmetric outer peripheral shape; wherein an outer peripheral portion of the mold mounting portion and an outer peripheral portion of the rear surface portion are connected together by means of an outer peripheral portion connection member 3c; and wherein a step is provided between a mold-mounting-side of the reaction force receiving portions and the mold mounting surface of the mold mounting portion (as clearly shown in Figs. 2 and 3). Becker et al. also inherently teach a molding method for injection molding molten resin into the mold cavity of a mold mounted to such a mold support platen, as claimed.

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Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Joyner (U.S. Patent 5,123,834).

Joyner teaches a mold support platen 22 including an annular cavity portion defined between the mold mounting portion 70 (having mold mounting surface 40) and the rear surface portion 72, the annular cavity portion surrounding a central connection member (defined by plural symmetrical members 74 interconnecting the mold mounting portion and the rear surface portion), the annular cavity portion being located within an outer peripheral portion connection member (defined by plural members 76 interconnecting the mold mounting portion and the rear surface portion), and further including a through-hole communicating with the annular cavity portion and formed in a surface adjacent to the mold mounting surface (as clearly shown in Figs. 1-4 and 7-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either EP 1,287,962 or Becker et al. (U.S. Patent 6,776,605), in view of Oshiro et al. (U.S. Patent 5,910,328).

Each of EP '962 and Becker et al. disclose the mold support platen substantially as claimed, as described above, except for explicitly disclosing the rear surface portion having a mounting portion which is secured to a frame, the mounting portion being "provided at a location [on the rear surface portion] such that deformation of the rear surface portion in the vertical direction is suppressed" as claimed in claim 20. Oshiro et al. disclose a stationary mold support platen 27 including a mounting portion 25, 27c secured to machine frame 23, the mounting portion provided at a location such that deformation of the platen in the vertical direction is suppressed. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify either EP

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'962 or Becker et al. by providing a mounting portion to mount the platen to a frame, as suggested by Oshiro et al., in order to suppress deformation of the stationary platen in the vertical direction.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Mackey/
Primary Examiner
Art Unit 1791

jpm
July 28, 2009